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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087896,805	07/18/97	MARTIN	000000001

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QM31/0610

EXAMINER  
NGUYEN, T

ART UNIT: 3700 PAPER NUMBER

DATE MAILED: 06/10/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/896,805**

Applicant(s)  
**MARTIN et al.**

Examiner  
**Tram Nguyen**

Group Art Unit  
**3738**



☒ Responsive to communication(s) filed on Mar 25, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-42 is/are pending in the application.

Of the above, claim(s) 31-40 is/are withdrawn from consideration.

☒ Claim(s) 1-30 and 42 is/are allowed.

☒ Claim(s) 41 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7, 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

***Election/Restriction***

1. Applicant's election with traverse of Group I in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the claims of Groups II and III, as now amended, set forth the particulars of the product as defined by claim 1 of Group I. With respect to applicant's traversal of Group II, the examiner has rejoined claim 30. However, the traversal of Group III is not found persuasive because Group III does not in fact set forth the particulars of the product of Group I. To illustrate, Group III requires a "ribbon *having* multiple spaced apart strips" (emphasis added), whereas the ribbon of Group I "forms multiple strips". The examiner asserts that these particulars are not one and the same. That is, the ribbon of Group I could be a unitary strip of material, whereas the ribbon of Group III could be a combination of many strips of materials attached together to make up what is collectively termed the "ribbon". Furthermore, that Group I and Group III have acquired a separate status in the art as shown by their different classification is evidence that the restriction is proper.

The requirement is still deemed proper and is therefore made FINAL.

***Information Disclosure Statement***

2. In response to applicant's arguments in Paper No. 10, the examiner has withdrawn all prior objections with respect to applicant's statement pursuant to 37 C.F.R. §1.56 regarding copending applications.

***Claim Rejections - 35 USC § 112***

3. In response to applicant's amendments in Paper No. 10, the examiner has withdrawn all prior 35 U.S.C. § 112 rejections.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 41 is rejected under the judicially created doctrine of double patenting over claims 1, 2 and 4 of U. S. Patent No. 5,876,432 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a tubular stent having multiple undulations, each undulation having an amplitude, a tubular graft member positioned within the tubular stent, and a coupling member extending through undulations of the tubular stent to contact at least an inner or an outer surface of the stent and forming multiple windings spaced from one another, the multiple windings covering only a portion of the undulations. Insofar as the multiple undulations of the tubular stent are helically arranged, and the coupling member extends along the undulations of the tubular stent, the coupling member is inherently also helically arranged.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-30 have been considered and was found persuasive by the examiner. With respect to newly added claims 41 and 42, please refer to the above double patenting rejection.

***Allowable Subject Matter***

7. Claims 1-30 and 42 are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to disclose or teach a stent-graft combination wherein the stent and graft are attached to each other by means of a ribbon, which is *adhered* to the stent member and forms *multiple strips* from one another (emphasis added). Furthermore, the prior art fails to disclose or show a helically configured ribbon which interconnects less than entirely one of the inner and outer surfaces of the graft to the stent.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Mickey Yu  
Supervisory Patent Examiner  
Group 3700



TAN  
June 6, 1999